

## **REMARKS**

Applicants propose amending claims 12 and 13 solely for clarity and to adopt suggestions made by the Examiner. Accordingly, Applicants request that the Examiner enter the amendments. Claims 1-3 and 7-14 are pending in this application.

In the Final Office Action,<sup>1</sup> the Examiner rejected claims 12-14 under 35 U.S.C. § 112, second paragraph; rejected claims 1, 3, 7-9, and 11-14 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff et al. (U.S. Patent No. 6,385,591) in view of Sim (KR2000030358A); and rejected claims 2 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Sim and in further view of Golden et al. (U.S. Patent No. 5,781,648).

### **I. REJECTION OF CLAIMS 12-14 UNDER § 112, ¶2**

Applicants respectfully traverse the rejection of claims 12-14 under 35 U.S.C. § 112, second paragraph, as being indefinite. However, in an effort to expedite prosecution, Applicants have amended claims 12 and 13 as suggested by the Examiner. Furthermore, with regard to claim 14, the Examiner contends "[i]t is unclear what structure (programmed capability) is provided that enables the suggested redemption abilities." See Final Office Action at page 2. Applicants respectfully submit that the claim is not indefinite for this reason. That the coupon is redeemable by its display does not require a recitation of any structure that is used to redeem it. For example, Applicants' specification discloses that, in one embodiment, "[t]he consumer

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<sup>1</sup> The Final Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Final Office Action.

can then visit the retail location and show the retailer the promotional information (coupon) displayed on the wireless device in order to redeem the coupon.” See page 3, paragraph [007].<sup>2</sup> Applicants further note that the MPEP explains that the test for indefiniteness is whether “the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” See MPEP §2173 at § 2173.02 (“Clarity and Precision”). “If the claims when read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.” *S3, Inc. v. Nvidia Corp.*, 259 F.3d 1364, 1367, 59 USPQ2d 1745, 1747 (Fed. Cir. 2001), quoting *Miles Laboratories, Inc. v. Shandon*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993). Since the claims meet the requirements of 35 U.S.C. § 112, second paragraph, Applicants request that the Examiner withdraw the rejection.

## **II. REJECTION OF CLAIMS 1, 3, 7-9, AND 11-14 UNDER § 103(a)**

Applicants respectfully traverse the rejection of claims 1, 3, 7-9, and 11-14 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Sim because a *prima facie* case of obviousness has not been established. With regard to Sim, Applicants note that Examiner’s citations in the Office Action and Applicants’ citations in this paper are with respect to WO 01/63507 A1, an English language version of Sim.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or

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<sup>2</sup> In making reference to the specification, it is to be understood that Applicants are in no way intending to limit the scope of the claims to the exemplary embodiments described in the specification. Rather, Applicants expressly affirm that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation and applicable case law.

references, taken alone or combined, must teach or suggest each and every element recited in the claims. See MPEP § 2143.03. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See MPEP § 2143.01. Third, a reasonable expectation of success must exist. See MPEP § 2143.02. Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See MPEP § 2143. In this application, a *prima facie* case of obviousness has not been established for at least the reason that the applied references, taken alone or in combination, do not teach or suggest all of the elements of the claims.

Independent claim 1 recites a method including, among other steps, "in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer an identifier associated with a second user computer" and "in response to the receipt of the identifier, transmitting a coupon to the second computer." Mankoff and Sim, whether taken individually or in combination, do not teach at least these elements of independent claim 1.

In the Response to Arguments section of the Final Office Action, the Examiner contends "it would have been obvious to one of ordinary skill at the time of the invention to have clicked a banner on a PC from a user's home and requested registration of his cell number so that the coupon can be delivered to his portable cell for redemption in the store as described." See Final Office Action at page 5. Applicants respectfully submit that the Examiner has not pointed to any teaching in Mankoff or Sim that discloses or suggests such a feature. Nor has the Examiner pointed to any teaching in

Mankoff or Sim that suggests a modification of either reference to incorporate the Examiner's allegation. Rather, the Examiner's allegation is unsubstantiated by any factual evidence in the record, such as a competent prior art reference. In the absence of such a prior art reference, a *prima facie* case of obviousness has not been made and the Examiner should withdraw the rejection of independent claim 1 for at least this reason. Should the Examiner maintain the current rejections after consideration of the reasoning presented herein, Applicants respectfully request that the Examiner identify the portion or portions of the references that provide evidence of a suggestion to modify Mankoff or Sim in the manner proposed by the Examiner.

Mankoff does not teach or suggest each and every element of independent claim 1 for at least the following reasons. In the Mankoff system, a coupon is transmitted from a server directly to either a personal computer or a PDA (Fig. 1), a PDA is synchronized with a personal computer to download coupon offers to the PDA (Fig. 2), or a coupon is directly downloaded to a PDA from a retail site web server (Fig. 3). Thus, Mankoff discloses direct transmission of a coupon to a device. However, Mankoff fails to disclose or suggest that "in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer an identifier associated with a second user computer" and "in response to the receipt of the identifier, transmitting a coupon to the second computer," as recited in independent claim 1 (emphasis added).

Moreover, Sim does not compensate for the deficiencies of Mankoff. Instead, Sim discloses "a coupon serving system [which] allows a customer to buy commodities or use services through the use of coupons received in his or her wireless

communication terminal equipment.” See page 3. In the Sim system, data transmitting server 7 includes a coupon data transmission program that transmits coupon data to wireless communication terminal equipments 2. See page 4. Thus, Sim discloses direct transmission of a coupon from a server to a wireless device. However, Sim does not teach or suggest “receiving from the user through the first user computer an identifier associated with a second user computer” and “in response to the receipt of the identifier, transmitting a coupon to the second computer,” as recited in independent claim 1 (emphasis added).

For at least the above reasons, Mankoff and Sim, taken individually or in combination, do not teach or suggest each and every element of independent claim 1. Furthermore, independent claims 9 and 12, while of a different scope from claim 1 and each other, includes recitations of a similar scope as claim 1. Accordingly, a *prima facie* case of obviousness has not been established with respect to independent claims 1, 9, and 12. Furthermore, claims 3, 7, 8, 11, 13, and 14 are allowable at least due to their dependence from allowable independent claims 1, 9, and 12. Therefore, the Examiner should withdraw the rejection of claims 1, 3, 7-9, and 11-14 under 35 U.S.C. § 103(a).

### **III. REJECTION OF CLAIMS 2 AND 10**

Applicants respectfully traverse the rejection of claims 2 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Sim and in further view of Golden.

As discussed above, Mankoff and Sim, individually or in combination, do not teach or suggest “in response to and in association with the display of the banner

advertisement, receiving from the user through the first user computer an identifier associated with a second user computer” and “in response to the receipt of the identifier, transmitting a coupon to the second computer,” as required by independent claims 1 and 9, from which claims 2 and 10 respectively depend. In the Final Office Action, the Examiner contends Golden teaches “a feature whereby the user may download only a certain number of coupons.” See Final Office Action at page 5. Even if the Examiner’s characterization of Golden is correct, which Applicants do not concede, Golden does not compensate for the deficiencies of Mankoff and Sim already discussed. That is, Golden also does not teach or suggest that “in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer an identifier associated with a second user computer” and “in response to the receipt of the identifier, transmitting a coupon to the second computer,” as required by independent claims 1 and 9.

Claims 2 and 10 depend from independent claims 1 and 9, respectively. Accordingly, even if Golden were combined with Mankoff and Sim as the Examiner proposed, the combination still does not teach or suggest all elements recited in independent claims 1 and 9, and required by dependent claims 2 and 10. Accordingly, Mankoff, Sim, and Golden, taken individually or in combination, do not teach or suggest all of the elements required by dependent claims 2 and 10. Therefore, the Examiner should withdraw the rejection of claims 2 and 10 under 35 U.S.C. § 103(a).

### **CONCLUSION**

Applicants respectfully request that the Examiner enter this Amendment under 37 C.F.R. § 1.116, placing claims 1-3 and 7-14 in condition for allowance. Applicants

submit that the proposed amendments of claims 12 and 13 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the Final Office Action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow Applicants to reply to the final rejections and place the application in condition for allowance. Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

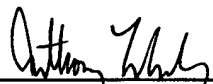
In view of the foregoing, Applicants request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: March 30, 2007

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